

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAF ANTHIAS

Appeal No. 97-1227
Application 08/163,416¹

ON BRIEF

Before KRASS, FLEMING and LEE, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4. Claims 5-8 have been cancelled. No claim has been allowed.

References relied on by the Examiner

Eagen et al. (Eagen)
1995

5,461,716

Oct. 24,

¹ Application for patent filed December 6, 1993.

Appeal No. 97-1227
Application 08/163,416

(Effective filing date May 22, 1990)

The Rejections on Appeal

The rejections set forth in the final Office action (Paper No. 7) are presumed to have been withdrawn by the examiner, since they are not reiterated in the examiner's answer. The following new grounds of rejection, however, are set forth in the examiner's answer (Paper No. 12):

1. Claims 1 and 3 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Eagen.
2. Claims 2 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eagen.

The Invention

The invention is directed to management or storage of the window display data in a distributed client/server presentation system. Claim 1 is the sole independent claim and is reproduced below:

1. A data processing system comprising:
 - a display terminal,
 - a local processor connected to said display terminal and connected to a local processor memory,
 - a remote processor connected to said local processor and connected to a remote processor memory,
 - said remote processor including means for executing a plurality of application programs and means for sending window

Appeal No. 97-1227
Application 08/163,416

display data generated by said application programs to said local processor,

said local processor including means for receiving said window display data and drawing respective application windows, each of said application windows containing at least one subarea window within its perimeter,

said application programs designating at least one of said subarea windows as an action field through which a user may access a respective application program,

means for storing said respective application program window display data and said corresponding action field in the local processor memory, and

means for storing remaining display data in the remote processor memory.

Opinion

We do not sustain the examiner's rejection of claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by Eagen.

We do not sustain the examiner's rejection of claims 2 and 4 under 35 U.S.C. § 103 as being unpatentable over Eagen.

Our opinion is based only on the arguments raised in the appellant's briefs. Arguments not raised by the appellant are not before us, are not at issue, and are considered as waived.

In the reply brief on page 4, the appellant states:

This division of storage [feature] is fundamental to applicant's invention and is clearly recited in the last two paragraphs of applicant's claim 1. (Emphasis in original.)

Appeal No. 97-1227
Application 08/163,416

According to the appellant (reply brief at 3), "[e]ach claim requires storage of the respective application program window display data and corresponding action field in the local processor memory, and storage of remaining display data in the remote processor memory." The appellant states (Reply at 4): "[I]n Eagen et al., there is no division of storage, as claimed by the appellant." [Emphasis added].

The appellant's argument is misplaced. Claim 1 has no language which actually requires any "division of storage." Both the host processor and the local processor can store the entirety of the display data and that would still be within the defined scope of claim 1. All that is required is that the local processor memory stores certain display data and the host processor stores certain remaining display data. Nothing precludes either processor from storing additional data including data already stored in the other processor.

Citing column 9, lines 26-29 and column 9, line 68 to column 10, line 2, the examiner finds that Eagen teaches transmitting only the desired window panel contents to the local processor from the host processor (Supp. Answer at 5). Citing column 8, lines 29-32, the examiner finds that

remaining display data is stored at the host site until the user requests display of the information at the remote site (Supp. Answer at 5). We have reviewed the above-noted portions of Eagen cited by the examiner and can find no reasonable basis for the examiner's findings. In Eagen, the desired window panel contents is the entirety of the desired window display and is transmitted from the host to the local processor. There is no indication that after the transmission the host stores in the host's memory any of the display data which has been transmitted to the local processor.

Furthermore, with regard to Eagen, it appears that the examiner has regarded the "underlying panel data" replaced by a desired window display as the remaining data. With regard to the "remaining display data," the examiner cited (Supp. Answer at 4) to column 11, lines 7-9 of Eagen, which states: "Finally, underlying panel data does not need to be transmitted from the host processor to the DWS when a window is removed, which also significantly reduces communications time required to support remote workstations." It is an incorrect assumption from the quoted portion of Eagen that the host stores the underlying panel data. A reading from column

Appeal No. 97-1227
Application 08/163,416

10, line 64, to column 11, line 13, reveals that when removing a window display the host need not send the underlying panel data back to the local processor for display because the local processor did not at first, when originally creating the window on display, send to the host the underlying panel data for storage.

For the foregoing reasons, the rejection of claims 1 and 3 as being anticipated by Eagen and claims 2 and 4 as being unpatentable over Eagen cannot be sustained on the basis of the examiner's stated rationale regarding what data is stored in the host. Additionally, the rejection of claims 2 and 4 cannot be sustained because the examiner has cited no prior art which reasonably would have suggested to one with ordinary skill that the appearance of the cursor changes as it enters and leaves an action field within the display. Eagen's generally teaching a "full range" of cursor controls nonetheless still fail to reasonably suggest changing the cursor's appearance as it enters and leaves the action field.

New Grounds of Rejection
under 37 CFR § 1.196(b)

Unpatentable over Eagen

Claim 1 specifies that the window display data **and** the action field are stored in the local processor. But the action field as defined in claim 1 is a subset of the window display data. Claim 1 recites: "said application programs designating at least one of said subarea windows as an action field through which a user may access a respective application program." In the context of appellant's claim 1, to the extent that it can be understood, then, no window display data remains. Therefore, the host processor need not store any display data, to satisfy claim 1. On this rationale, it does not matter what the host processor stores, because it need not store anything. And we have already determined above that in Eagen, the local processor stores the entirety of the window display which, of course, includes the subarea action field. Thus, claim 1 is herein rejected as being anticipated by Eagen under 35 U.S.C. § 102(e).

With respect to claim 3 which depends from claim 1, the examiner's finding (Supp. Answer at 4) that Eagen teaches that user input data is entered in one of the action fields has not been challenged or refuted. Accordingly, claim 3 is also

Appeal No. 97-1227
Application 08/163,416

herein rejected as being anticipated by Eagen under 35 U.S.C.
§ 102(e).

Indefiniteness under 35 U.S.C. § 112, Second Paragraph

Claim 1 is vague and indefinite because the reference to "remaining display data" has no clear meaning. Since the action field is a subset of the window display, it is necessarily included in the window display data. In the context of the claim, no display data remains, once the window display data and the corresponding action field is stored in the local processor memory. Thus, the reference to "remaining display data" is indefinite. Additionally, having all window display data stored in the local processor memory is not the subject matter which the appellant regards as his invention as it is disclosed in the specification. A plain reading of the specification reveals that the action field display data is stored in the local processor and the other portions of the window display is stored in the host processor memory. For instance, on page 3 of the specification, in lines 24-30, it is stated:

. . . . and is characterized in that display data
common to both an application window and a
corresponding action field is stored in the memory
associated with the local processor and remaining

Appeal No. 97-1227
Application 08/163,416

display data is stored in the memory associated with the remote processor. (Emphasis added.)

Original claim 1 filed with the specification recites language similar to the foregoing. It should be noted that the term "common to both" specifies the intersection between the two, which is the action field and not the entire window display.

For all of the foregoing reasons, claims 1-4 are herein rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly define and distinctly claim that subject matter which the applicant regards as his invention.

Conclusion

The rejection of claims 1 and 3 under 35 U.S.C. § 102(e) as being anticipated by Eagen is reversed.

The rejection of claims 2 and 4 under 35 U.S.C. § 103 as being unpatentable over Eagen is reversed.

Pursuant to 37 CFR § 1.196(b), **claims 1 and 3 are herein rejected** under 35 U.S.C. § 102(e) as being anticipated by Eagen.

Pursuant to 37 CFR § 1.196(b), **claims 1-4 are herein rejected** under 35 U.S.C. § 112, second paragraph, for failing

Appeal No. 97-1227
Application 08/163,416

to particularly point out and distinctly claim that subject matter which the applicant regards as his invention.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 97-1227
Application 08/163,416

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED-196(b)

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	

Appeal No. 97-1227
Application 08/163,416

JAMESON LEE) INTERFERENCES
Administrative Patent Judge)

sd

J. B. Kraft
INTERNATIONAL BUSINESS MACHINES CORP.
Intellectual Property Law Dept.
11400 Burnet Road, Internal Zip 4054
Austin, TX 78758